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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,096	04/01/2005	Masashi Kudo	121036-0078	5558

7590 07/03/2007  
Michael S Gzybowski  
Butzel Long  
350 South Main Street  
Sutie 300  
Ann Arbor, MI 48104

EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

MAIL DATE	DELIVERY MODE
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07/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/530,096

Applicant(s)

KUDO ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 4/6/07 Repsonse.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-10, 15-19 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 2-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-19 and 32 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's election of the invention of Group III (Claims 15-19 and 32) in the response to restriction requirement filed on April 6, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The requirement is still deemed proper and is therefore made FINAL.

Groups I and II, Claims 2-10, are withdrawn for further consideration.

2. Claim objection(s) in the previous Office Action (Paper No. 111106) is/are removed.

3. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 111106) is/are removed.

4. Claim rejection(s) under double patenting rejection in the previous Office Action (Paper No. 111106) is/are removed because the U.S. Application No. 10/506,488 has been abandoned.

5. The indicated allowability of Claim 19 in the previous Office Action (Paper No. 111106) is withdrawn in view of the newly discovered reference(s) to Bentz (US 5 922 991). Rejections based on the newly cited reference(s) follow.

Examiner regrets for causing any inconvenience.

6. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

### ***Claim Objection***

7. Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In view of Applicants' clarification of the preambles in the independent claims (Amendment/Remarks filed February 15, 2007), now, Claim 19 does not further limit the subject matter of Claim 15.

***Claim Rejections - 35 USC § 112***

8. Claims 16-18 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claims 16-18 and 32 (line 1), in view of Applicants' clarification of the preambles in the independent claims (Amendment/Remarks filed February 15, 2007), the preamble "A sealing material" is now not consistent with that of Claim 15.

***Claim Rejections - 35 USC § 103***

9. Claims 15-19 and 32 are rejected under 35 USC 103(a) as being unpatentable over Bentz (US 5 922 991) in view of JP255 (JP 2000-154255).

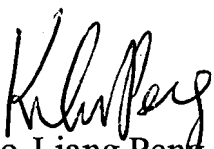
For Claims 15-19, Bentz discloses an automobile wire harness sealed by a sealing material to avoid the damages resulting from **vibration**, etc. (col. 1, line 12 to col. 2, line 25 and Figures) Bentz is silent on the use of the specific material set forth in the present invention for the seal. However, JP255 teaches a sealing material comprising A) an acrylic polymer containing at least one alkenyl group, B) a hydrosilyl group-containing compound and a hydrosilylation catalyst. ([0005], [0078], [0086] and Examples) Component A) can be derived from ethyl acrylate,

n-butyl acrylate, 2-methoxyethyl acrylate and 1,7-octadiene. ([0008], [0032] and Examples) The molecular weight distribution of Component A) can be 1.8 or less. ([0010]) The molecular weight of Component A) is described in [0011]. The hardness of the cured composition is exemplified in [0094]. A filler can be used. ([0081]) Since JP255's material is substantially the same as that of Applicants', both should possess the same properties including compression set, loss tangent, etc. JP255's sealing material has **vibration absorption** capability for using in automobiles. ([0086]) The motivation of using the sealing material is to dampen the vibration. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's sealing material for Bentz's wire harness seal material with expected success.

For Claim 32, JP255 is silent on the amount of the filler. However, the filler amount will affect the physical properties of the cured material. In other words, the filler amount is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a filler in whatever amount through routine experimentation in order to obtain a cured material having desired properties. Especially, Applicants do not show the criticality of the filler amount. See MPEP 2144.05 (II).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
June 18, 2007

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712